

**REMARKS**

With this response, no claims are amended, added, or canceled. Claims 1-22 remain pending. Further examination and reconsideration of the present application are respectfully requested.

**Priority**

The Office Action has stated the disclosure of the prior-filed application fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In reliance upon this assessment, the Examiner has stated that claims 1-7 and 12-22 are deemed to have a later filing date of 02/05/2004. The Examiner has then applied intervening prior art to reject these claims as being unpatentable under 35 USC §§102, 103 (These rejections are discussed further below.).

The refusal to afford priority to claims 1-7 and 12-22 is respectfully traversed. All claims of the present application find full written description support and enablement in the original priority document, and thus are entitled to a claim priority date of March 5, 1998. The intervening documents are not available as prior art. For the Examiner's convenience, a copy of the original priority document (U.S. Pat. Appl. No. 09/035595, filed March 5, 1998) is enclosed.

The priority document describes specific polymer embodiments that incorporate fluorinated segments derived from fluorinated oxetane monomers. However, the skilled worker would readily recognize that the principles of the present invention are not so limited. Reading the specification as a whole, the skilled worker would appreciate that the priority document describes novel fluorinated polymers that provide stain resistance and dry erase characteristics (when reacted with melamine resin) when the following combination of characteristics is present:

- The polymer includes both polyether and polyester segments;
- The polyether segments include alkylene oxide (i.e., polyether) repeat units such as the one that results when oxetane is polymerized; and
- Fluorinated moieties are pendent from the polyether segment(s); and
- The pendent fluorinated moieties are fluoroalkoxyalkyl groups, i.e., a fluorinated moiety is linked to the polyether segment of the backbone via a linkage including an ether moiety.

The present claims embody this combination of features and thus are commensurate in scope with the priority document.

For example, please refer to the passages from page 6, lines 4 to page 7, lines 2 of the priority document, and particularly the illustrative polymer segment structure shown at page 6, lines 6-9. The illustrated polymer segment shows an illustrative polymerized unit derived from a fluorinated oxetane monomer. When the oxetane monomer is polymerized, the molecule ring opens and the illustrated unit of the polymer chain is formed. Although the specific polymer segment illustrated happens to be a propylene oxide with a pendent R group and a pendent group  $-\text{CH}_2\text{O}(\text{CH}_2)_n\text{Rf}$ , the skilled worker would readily recognize more generally that the important features of the resultant repeat unit are (1) that the backbone is an alkylene oxide repeat unit ( a polyether segment) and (2) that the pendent  $-\text{CH}_2\text{O}(\text{CH}_2)_n\text{Rf}$  is a fluoroalkoxyalkyl moiety by which the Rf group is linked to the polyether repeat unit via an ether moiety.

Just as was the case of In re Peters, 221 USPQ 952 (Fed. Cir. 1983), the priority document conveys to the skilled worker that the present inventors had possession of a polymer having the combination of features that are presently claimed. In that case, the Federal Circuit held that claims broader than the specific embodiment shown in the specification are nonetheless fully supported by the specification when the important concepts presented in the description are

presented in the claims at issue. As one factor in its analysis, the In re Peters Court reasoned that the claims were acceptable because if they had been submitted with the original application, "it is difficult to perceive how they could have been properly rejected under § 112.

In the present application, just as was the case in In re Peters, the important features of the priority document are recited in the present claims, and the present claims certainly would have satisfied Section 112 if submitted with the original disclosure:

- The recited polymer includes polyether (polyalkylene oxide) and polyester segments;
- The recited fluorinated groups are pendent from the polyether segments; and
- The recited fluorinated groups are linked to the polyether segments via ether linkages.

Applicants have presented claims of a scope fairly commensurate with, and supported by, the teachings of the original priority document. The skilled worker would recognize upon reading the claims that the claims reflects what has been invented.

Accordingly, it is respectfully submitted that claims 1-7 and 12-22 are entitled to a priority date of March 5, 1998.

### **Double Patenting**

Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (a) claims 1-43 of U.S. Patent No. 6,686,051; or
- (b) claims 1-88 of U.S. Patent No. 6,660,828; or
- (c) claims 1-32 of U.S. Patent No. 6,383,651; or
- (d) claims 1-32 of U.S. Patent No. 6,423,418.

Claims 1-22 also are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (a) claims of copending Application No. 10/492,472 (US 2004/0219378); or
- (b) claims 44-60 of copending Application No. 10/966,528 (US 2005/0048213).

With respect to U.S. Pat. Nos. 6,686,051, 6,383,651, 6,423,418, and U.S. Serial No. 10/966,528, enclosed is a Terminal Disclaimer encompassing these documents. It is respectfully submitted that the filing of this Terminal Disclaimer overcomes the double patenting rejections of record as to these three patents.

With respect to U.S. Pat. No. 6,660,828, and U.S. Serial No. 10/966,528, it is respectfully submitted that the double patenting and provisional double patenting rejections are improper.

With respect to U.S. Pat. No. 6,660,828, the claims of that patent recite compositions in which the fluorinated polymer includes polar groups. The resultant polymers are a useful additive for controlling flow or leveling properties. In contrast, the present claims do not recite the presence of polar groups. Further, the claims of the present application recite laminate structures including the crosslinked reaction product a reactive fluorinated polymer and a reactive melamine resin. In contrast, the '828 patent claims do not recite laminates or reactive melamines.

Because the '828 patent and the present claims each recite patentably distinct features not recited in the other, the double patenting rejection over the '828 patent is improper and should be withdrawn.

With regard to U.S. Serial No. 10/966,528, those claims recite a method of providing an article with a thermoformed coating. A two stage curing method is recited in claims 1-15; a method of partial curing is recited in claims 16-25. In the present application, only a portion of the claims constitute method claims, and these do not recited two stage or partial curing. To the extent that the present claims are generic with respect to U.S. Serial No. 10/966,528, the present claims have an earlier priority date. Under these circumstances, the double patenting rejection is improper and should be withdrawn.

**Claim rejections under 35 USC 102**

Claims 1-7, and 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- (a) Weinert et al. (US 6,383,651); or
- (b) Callicott et al. (6,523,418); or
- (c) WO 99/450079 (WO '079).

As discussed above, claims 1-7 and 12-22 are entitled to a priority date of March 5, 1998. Accordingly, none of the cited documents is available as prior art under 35 USC 102(b). Withdrawal of the rejections is respectfully requested.

**Claim rejections under 35 USC 103**

Claims 1-7, and 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

- (a) Weinert et al. (US 6,383,651); or
- (b) Callicott et al. (6,523,418); or
- (c) WO 99/450079 (WO '079).

As discussed above, claims 1-7 and 12-22 are entitled to a priority date of March 5, 1998. Accordingly, none of the cited documents is available as prior art under 35 USC 103(a). Withdrawal of the rejections is respectfully requested.

**CONCLUSION**

In view of the above remarks, it is respectfully submitted that the claims and the present application are now in condition for allowance. Approval of the application and allowance of the claims is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact said attorney at (651) 275-9804.

Respectfully Submitted,

By: David B. Kagan  
David B. Kagan, Reg. No. 33,406  
**Customer Number 33072**  
Phone: 651-275-9804  
Facsimile: 651-351-2954

Dated: June 27, 2006